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JUL 21 2004

In re Application of : **OFFICE OF PETITIONS**
Noguchi, Terada, Ohashi, and :
Komazaki :
Application No. 10/668,379 : DECISION REFUSING STATUS
Filed: 24 September, 2003 : UNDER 37 CFR 1.47(a)
Attorney Docket No. OKI 377 :

This is in response to the petition under 37 CFR 1.47(a)¹ filed on 9 June, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

On 24 September, 2003, the above-identified application was filed.

Accordingly, on 16 December, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, stating that an executed oath or declaration, the statutory basic filing fee, and a surcharge for their late filing were required.

In response, on 9 June, 2004, petitioners filed a four (4) month

¹A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

extension of time, the statutory basic filing fee and surcharge, and the present petition and petition fee. Additionally, a declaration was filed naming Kazuahige Noguchi, Satoshi Terada, Wataru Ohashi, and Tomokazu Komazaki as joint inventors and signed by all inventors except Terada on behalf of themselves and joint inventor Terada.

Petitioners assert that a copy of the application was sent to the last known address of the non-signing inventor, but that the inventor has failed to return a signed declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). The declaration is defective in that does not include a proper statement of the residence of the non-signing inventor, or the non-signing inventor's correct mailing address. With regard to the former, applicant's place of residence, that is, the city and either state or foreign contry, is required to be included in the oath or declaration.² Petitioners have not included the city in which the non-signing inventor resides on the declaration. With regard to the latter, it is noted that the same mailing address : that of the former employer of the non-signing inventor, has been used for three of the four inventors, including the non-signing inventor. The oath or declaration must identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each

²See MPEP 605.02

inventor.³ Obviously the non-signing inventor does not receive mail at this address since, as petitioners state, he no longer is employed by Oki Electric Industry Co., Ltd. Petitioners must submit a new oath or declaration in compliance with 37 CFR 1.67 and 1.67, signed by all of the signing inventors on behalf of themselves and the nonsigning inventor, with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

OR,
for correspondence filed after 28 September,

2004:⁴

(571) 273-0025
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

³37 CFR 1.63(c).

⁴It is anticipated that the Office of Petitions will complete its move to the new USPTO Carlyle office building in Alexandria, Virginia on or about this date.